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AUG 03 2007

OFFICE OF PETITIONS

In re Application of	:	
Yosi Bar-Erez	:	
Application No.: 09/581990	:	DECISION ON
Filing or 371(c) Date: 06/21/2000	:	PETITION
Attorney Docket Number: 1529	:	

This is a decision in response to the Re-Petition to Withdraw Holding Abandonment, filed June 19, 2007. The petition is properly treated as a renewed petition under 37 CFR 1.181. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed May 5, 2004, wherein the Examiner rejected claims 26-45, 51, 52, 55 and 56. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a Notice of Appeal in response to the Office action on September 9, 2004, and Appeal Brief on January 3, 2005. The Examiner filed an Answer on March 21, 2005. The Board of Patent Appeals and Interferences ("Board") issued an Order returning the appeal to the Examiner on July 27, 2005, and the Examiner issued a Notice of Defective Appeal Brief on August 9, 2005. Applicant filed an Appeal Brief on September 7, 2005. The Examiner filed an Answer on December 5, 2005. The Board issued a Decision on November 16, 2006, affirming all rejections on appeal. No claims having been allowed, and no response to the Board's decision having been filed, proceedings in the application are terminated as of January 17, 2007. The application is abandoned.

Applicant filed a petition on January 16, 2007, wherein Applicant asserted non-receipt of the Board Decision.

The petition was dismissed in a Decision mailed April 20, 2007. The Decision dismissing the petition informed Applicant that Applicant must, in addition to stating that the Board Decision was not received, also state that a search of the file jacket and docket records reveal that the Board Decision was not received, and provide a copy of the file jacket and docket records to this Office.

It was also noted that the correspondence address of record indicated that the Board Decision was mailed to Applicant care of Bill Polkinghorn at Discovery Dispatch. Applicant was advised that the statement of non-receipt must be from a person with firsthand knowledge of the non-receipt, in this instance, the person receiving Applicant's correspondence at Discovery Dispatch. Finally, the Decision reiterated that the showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

The present Re-Petition

Applicant files the present re-petition and, in relevant part, the Declaration of Bill Polkinghorn, wherein Mr. Polkinghorn states that he packages all the mail, and hand-delivers it to a DHL courier who picks it up from Mr. Polkinghorn personally to send to Dr. Friedman in Israel, and Mr. Polkinghorn notifies Dr. Friedman of the DHL waybill number.

Applicant has not filed any evidence outside of Mr. Polkinghorn's personal Declaration as to the correspondence that has been received from this Office, i.e. a docket record or file jacket maintained by Mr. Polkinghorn.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been

entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). (Emphasis supplied)

MPEP 711.03(c)

Analysis

Applicant's re-petition states that, after an Office communication is received at the correspondence address of record, it is then sent via DHL courier to Israel. There are circumstances, therefore, that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail. Additionally, Applicant avers that he received the Board Decision; however, Applicant has not provided any evidence of a system in place to record Office communications received from this Office. The showing of non-receipt must be from the correspondence address of record. The requirement is to submit a copy of the file jacket and docket record where the nonreceived Office communication would have been entered had it been received and docketed. Here, the location where the Board Decision would have been received is Upper Marlboro, Maryland. However, no file jacket and docket record for Upper Marlboro, Maryland, has been submitted. Instead, a copy of the file jacket and docket record for Petitioner's address in Israel has been submitted in an effort to demonstrate nonreceipt of the Board decision mailed to Upper Marlboro, Maryland. The showing is insufficient.

Conclusion

Applicant has failed to demonstrate that the Office communication was not received.

A copy of the Board Decision accompanies this Decision.

Alternate venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive

under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions

Enclosure: Board Decision

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSI BAR-EREZ

Appeal 2006-2272
Application 09/581,990
Technology Center 1700

Decided: November 16, 2006

Before PAK, WALTZ and GAUDETTE, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's final rejection of claims 26 through 45, 51, 52, 55, and 56, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to Appellant, the invention is directed to a method and apparatus for making a three-dimensional object made from a large number of preformed sheets each bonded on one side to the next adjacent sheet on its

opposite side, with each sheet cut along a contour corresponding to the contour of the respective layer constituted by the sheet in the object (Br. 4-5).¹ Appellant's method includes the step of selectively applying a releasing agent effective to inhibit bonding between adjacent sheets, such that the remaining portion of the sheet not within the contour is readily separable from the three-dimensional object (Br. 4). Claims 26 and 36 are illustrative of the invention and are reproduced below:

26. A method of making a three-dimensional object constituted of a large number of thin performed sheets each bonded on one side to the next adjacent sheet on its opposite side, with each sheet cut along a contour corresponding to the contour of the respective layer constituted by the sheet in the object, the method comprising selectively applying to one side of each sheet a releasing agent effective to inhibit bonding between adjacent sheets, the releasing agent being applied selectively in a manner such that, after the sheet has been bonded to the next adjacent sheet on that side, the surface of the sheet within the respective contour is bonded to the next adjacent sheet, while the remaining portion of the respective sheet not within said contour is readily separable from the three-dimensional object.

36. Apparatus for making a three-dimensional object constituted of a large number of thin preformed sheets each bonded on its opposite sides to the next adjacent sheets on its opposite sides, with each sheet cut by a cutting tool along a contour corresponding to the contour of the respective layer constituted by the sheet in the object, characterized in that said apparatus includes a releasing-agent applicator for selectively applying a coating on one side of each sheet, before being bonded to the next adjacent sheet on that side, of a releasing agent, said coating being selectively applied in a manner such that, after the respective sheet has been bonded to the next adjacent sheet on that side, the surface of the sheet within its respective contour is bonded to said next adjacent sheet, while the remaining portion of the respective sheet not within said contour may be readily separated from the three-dimensional object.

¹ We refer to and cite from the "Appellant's Brief" dated Sep. 07, 2005.

The Examiner has relied upon the following references as evidence of obviousness:

Miller	US 3,827,625	Aug. 06, 1974
Belanger	US 4,721,453	Jan. 26, 1988
Berman	US 5,071,503	Dec. 10, 1991
Feygin	US 5,730,817	Mar. 24, 1998
Kinzie	US 6,136,132	Oct. 24, 2000
Richards	US 6,161,604	Dec. 19, 2000

The following grounds of rejection are reviewed in this appeal:

- (1) claims 26-29, 51, and 55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Feygin in view of Kinzie (Answer 3); and
- (2) claims 30, 35-41, 43, and 56 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Feygin in view of Kinzie and Belanger (Answer 5 and 7).²

Based on the totality of the record, we affirm all grounds of rejection in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

² Claim 55 was inadvertently omitted by the Examiner from the rejection of claims 26-29 and 51 under § 103(a) over Feygin in view of Kinzie, as was claim 56 omitted from the rejection of claims 36-41, and 43 under § 103(a) over Feygin in view of Kinzie and Belanger (see the Final Office Action dated May 5, 2004, pages 2 and 5; Answer 3 and 7). We hold this error harmless as Appellant only argues claim 26 with any specificity in the Brief (see the Brief in its entirety). Furthermore, Appellant only requests that two grounds of rejection be reviewed on appeal (while eight rejections were presented in the Final Office Action dated May 5, 2004; Br. 5). Although these “grounds of rejection” listed in the Brief include claims that were not rejected over the listed references, we nevertheless consider all rejections involving the listed references, but limit our review to the consideration of claim 26 (and claim 36 to which the arguments for claim 26 above “apply equally”; Br. 12).

OPINION

The Examiner finds that Feygin discloses a method of making a three-dimensional object formed from a plurality of thin preformed sheets each bonded on one side to the next adjacent sheet, with each sheet cut along a contour corresponding to the contour of the respective layer constituted by the sheet in the object, where one side of a sheet is bonded to the opposite side of an adjacent sheet such that the remaining portion of the sheet not within the contour is readily separable from the three-dimensional object (Answer 3).

The Examiner recognizes that Feygin does not disclose the selective deployment of a releasing agent on one side of the sheet (Answer 4). The Examiner finds that one of ordinary skill in this art would have recognized the advantage of preventing the waste material from undesirably adhering to the sheets forming the three-dimensional object and used the teachings of Kinzie, who forms a three-dimensional object where a release coating is selectively applied to prevent undesired adhesion (*id.*). From these findings, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Feygin to include selectively coating the top side of each sheet with a releasing agent as taught by Kinzie to prevent undesired adhesion of the portion of the sheet comprising waste material to the portion of the sheet comprising a layer of the three-dimensional object (*id.*). We agree.

Appellant argues that Feygin does not suggest that selective non-adhesion would be advantageous (Br. 8). Appellant further argues that Feygin has no need for a selective bonding technique since this reference teaches an alternative technique for facilitating detachment of residue

material, namely, cross-hatching (Br. 8-9). Therefore Appellant argues that one ordinarily skilled in the art would have no motivation to seek an alternative solution as suggested by the Examiner (Br. 9).

Appellant's arguments are not persuasive. As correctly found by the Examiner (Answer 11-12), Feygin does not disclose a method which uses selective non-adhesion but the reference is also not limited to cross-hatching as a method of removing waste or residual material. Specifically, Feygin teaches that "the material outside of the [contour] line 80 is typically scrap, and is removed in various methods." (Feygin 5: 56-58). Feygin further teaches that "*one method* of removing unwanted material . . . [is] cross-hatching 82" (Feygin 5:60-62, italics added). Finally, Feygin teaches that "other methods of removing the unwanted material outside of the cut line 80 are possible, such as those described in U.S. Pat. Nos. 4,752,352 and 5,354,414." (Feygin 5:67-6:2). These "other methods" refer to, *inter alia*, U.S. Patent No. 5,354,414 to Feygin (hereafter Feygin '414), which is also discussed in Kinzie (1:55-67). Kinzie discloses a problem with the methods of Feygin '414 and others in the prior art, namely leaving the excess material in place for structural support in thin layer lamination "increases the need for selective bonding, to facilitate detachment of the excess material." (Kinzie 3:5-12). Kinzie teaches that in some cases "it may be appropriate to selectively apply a bond inhibitor, such as a protective layer or a release agent" closely coordinated with the lamination-press step (Kinzie 12: 4-9). Accordingly, we agree with the Examiner that one of ordinary skill in this art would have been motivated to selectively apply a releasing agent to the unwanted material outside of the cut line of Feygin, as taught by Kinzie, to facilitate removal or separation of this material. *See In re Fout*, 675 F.2d

297, 301, 213 USPQ 532, 536 (CCPA 1982)(“Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious. [Citation omitted].”).

Appellant argues that the bonding Kinzie refers to is the attachment of thick, rigid elements (Br. 9). Thus Appellant argues that the design considerations for attachment techniques are markedly different from those of thin-sheet stack construction such as disclosed by Feygin (*id.*).

These arguments are not well taken. As previously discussed, Kinzie teaches the “increasing need” for selective bonding when using laminated layers that are “thin” (Kinzie 3:5-12). Furthermore, it has been established that Feygin teaches that other methods of removal of unwanted material can be found in Feygin ‘414, which reference is also discussed by Kinzie (Kinzie 1:55-67). Accordingly, the “design considerations” referred to by Appellant would have been similar for all of the cited and applied prior art in the construction of laminated three-dimensional objects.

Appellant argues that any application of a releasing agent in Feygin would disrupt the binding between adjacent layers of the cross-hatched residue material around the object, therefore rendering the prior art invention unsatisfactory for its intended purpose (Br. 9).

This argument is also not well taken. As correctly noted by the Examiner (Answer 13), the proposed modification of Feygin would employ a releasing agent to selectively promote non-adhesion in lieu of employing the exemplified method of removing unwanted material, i.e., cross-hatching. The Examiner’s proposed modification never suggested using both methods to remove unwanted material.

Appellant argues that the combination suggested by the Examiner “lacks a reasonable expectation of success” in view of the highly undesirable results discussed above and the use of a general coating of a volatile solvent as suggested by Kinzie (Br. 11).

This argument is also not persuasive. As discussed above, using an equivalent or suggested alternative method of removal of unwanted material would have established a “reasonable expectation of success.” The “highly undesirable” results would not occur since, as also discussed above, the use of both a releasing agent and cross-hatching has not been suggested or proposed. Similarly, the use of both cross-hatching and the general coating of a volatile solvent has not been suggested or proposed.

The Examiner has additionally relied upon Belanger only for the disclosure of conventional means for applying a release agent (Answer 5, 8, and 15-16). Appellant argues that the method and context of Belanger differs from the claimed method and problem solved by the invention (Br. 13). Appellant further argues that the applicator (sprayer) of Belanger is unsuited for use in combination with Feygin (*id.*).

These arguments are not persuasive. Appellant has not disputed the Examiner’s finding that Belanger discloses conventional means for applying a releasing agent. The method of Belanger is not an issue in this rejection and Appellant has not provided any evidence or reasoning supporting the contention that the applicator of Belanger is “unsuited” for use in Feygin, especially in view of the Examiner’s finding that Kinzie discloses similar applicators for applying the adhesive bonding material (Answer 14).

For the foregoing reasons and those presented in the Answer, we determine that the Examiner has established a *prima facie* case of

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obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of Appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore we affirm all rejections on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

sld

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